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1   RECORD OF ORAL HEARING

2   UNITED STATES PATENT AND TRADEMARK OFFICE

3   _____

4   BEFORE THE BOARD OF PATENT APPEALS

5   AND INTERFERENCES

6   _____

7 *EX PARTE* TETSURO MOTOYAMA, AVERY FONG, and YEVGENIYA

8   LYAPUSTINA

9   _____

10   Appeal 2008-3003
11   Application 09/393,677
12   Technology Center 2100
13   _____

14   Oral Hearing Held: January 22, 2009

15   _____

16 Before JOHN C. MARTIN, LANCE LEONARD BARRY, and JEAN R.

17 HOMERE, *Administrative Patent Judges.*

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1   The above-entitled matter came on for hearing on Thursday, January

2   22, 2009, at The U.S. Patent and Trademark Office, 600 Dulany Street,

3   Alexandria, Virginia, before Victor Lindsay, Notary Public.

4   MS. BEAN: Good morning. We have calendar no. 48, Appeal

5   No. 2008-3003. Attorney Sachar for appellants.

6   JUDGE MARTIN: Thank you. Good morning, counsel.

7   MR. SACHAR: Good morning, Your Honors.

8   JUDGE MARTIN: You may proceed.

9   MR. SACHAR: Thank you. The invention at issue in this case is

10   directed to a system or method that monitors what operations a user selects

11   on an image forming apparatus. For example, what buttons a user selects on

12   a copy machine, a printer, a scanner, that type of device. That data is then

13   logged and communicated. The monitoring is realized to be performed

14   automatically without the user having to start a monitoring program. The

15   idea is that the user simply walks up, starts using the machine in their normal

16   usage, and that data is collected, monitored and sent, so you can find out

17   what the user is doing without the user being aware that they're being

18   monitored, the natural uses --

19   JUDGE HOMERE: Counselor, when does the monitoring start?

20   MR. SACHAR: It starts as soon as the machine starts up. So if you

21   come up to a machine --

22   JUDGE HOMERE: As soon as you turn it on or --

23   MR. SACHAR: Yes. So you turn the machine on, and it

24   automatically starts monitoring what operations the user selects.

1   JUDGE HOMERE: Why -- where -- can you show us where you

2   have the support for that, for automatically monitor -- start the monitoring

3   upon startup?

4   MR. SACHAR: In the -- written in the claims?

5   JUDGE HOMERE: In the specifications.

6   MR. SACHAR: In the specification, I believe we address that in the

7   appeal brief, and I'll draw your attention to -- let's see, we point to -- at the

8   bottom of page 3 of the appeal brief, we reference figure 13 that shows the

9   start monitoring function being called, and that's called automatically

10 without the user having to, to perform any command to, to call that function.

11   JUDGE HOMERE: Well, yes, and then -- and that's the

12 corresponding page to -- the page that discusses figure 13 is in page 20.

13   MR. SACHAR: Yes.

14   JUDGE HOMERE: And when you read that, I don't see anything in

15 there that discusses automatically monitoring. I mean, you have that start

16 monitoring control, but I don't see any indication that anything is being done

17 automatically here.

18   MR. SACHAR: Well, the --

19   JUDGE HOMERE: Can you point -- can you show me where you're

20 getting that from?

21   MR. SACHAR: The function that performs the monitoring is the start

22 monitoring function.

23   JUDGE HOMERE: I understand that, yeah, but there is no

24 description that how, how it actually works that actually it automatically

25 start monitoring upon startup of the, of the unit. So before we go any

3

1 further, I would like to know whether they have any basis for that at all,

2 whether that is actually new matter.

3   JUDGE BARRY: I'm sorry, I was trying to find this electronic file.

4 What are we -- where are we?

5   JUDGE HOMERE: The -- on -- we're looking at page 20.

6   JUDGE MARTIN: Specification on page 20.

7   JUDGE BARRY: Vis a vis something in the claim?

8   JUDGE HOMERE: Yes, the -- yeah, the critical element in the claim.

9   MR. SACHAR: The, the element is the start monitoring function.

10   JUDGE HOMERE: I understand that, sir.

11   MR. SACHAR: Right.

12   JUDGE HOMERE: And I'm trying to figure out how it actually

13 works, because this whole -- the, the entire argument in the brief hinges

14 upon that particular limitation, automatically, automatically upon startup of

15 the image from the device, start monitoring, and I'm trying to figure out --

16   JUDGE BARRY: So that --

17   JUDGE HOMERE: -- how this function describes that automatic

18 monitoring.

19   MR. SACHAR: Yeah, I think the support we would call is the, the

20 fact that the start monitoring block is executed without any user control.

21   JUDGE BARRY: That's in figure 13?

22   MR. SACHAR: Yes.

23   JUDGE MARTIN: Perhaps the problem, if there is one, is that the

24 description in the specs talks about a target application MB starting up, but

4

1   the claim is calling for the -- talking about startup of the device. Is that

2   right?

3   JUDGE HOMERE: Exactly.

4   JUDGE MARTIN: So it's, it's an application -- target application

5   versus device. Are those the same thing?

6   MR. SACHAR: Yes, those are the same things.

7   JUDGE HOMERE: Well, I thought the device itself is the printer or

8   the fax machine. You turn it on or -- and then automatically you have that

9   monitoring unit that comes on, and it starts monitoring. Now you say it's an

10 application. So which one?

11   MR. SACHAR: The, the device is the target application. The target

12 application is the device being monitored so if --

13   JUDGE MARTIN: So a device couldn't have more than one target

14 application that the user would turn on?

15   MR. SACHAR: No, no, no. The device is the target application.

16   JUDGE MARTIN: Yeah, that's what I mean, but it isn't defined that

17 way, right? I mean I'm just trying to figure out how broad these terms are,

18 like it seems like you could reconcile the claim language with the discussion

19 in the spec. You know, we're saying well, a device includes a target

20 application MB and that that -- and when that target application MB starts

21 up, then you have your function start monitoring begin. But maybe the

22 device has got -- or maybe you could turn on the device, and then wait a few

23 minutes, and then turn on the target application. Is that, is that what you

24 mean?

1   JUDGE HOMERE: No, I'm not exactly sure what's going on, because

2   one -- on the one hand -- on one hand they refer to a device which could be a

3   printer, a fax, and then on the other hand they, they refer to the target

4   application. So I'm not sure exactly what, what the -- this whole exact plan

5   is or if even reconcile with the specification.

6   MR. SACHAR: The, the target application is the device. That's,

7   that's the device that's being targeted to be monitored. So the fax machine

8   would be the device. The fax machine would also -- in the terminology

9   could also be the target application. So when that's turned on, the

10   monitoring operation begins.

11   JUDGE HOMERE: All right, proceed.

12   MR. SACHAR: The, the rejection is structured based on the primary

13   reference to Bolton, secondary reference to Varga. Bolton is directed to a

14   device that allows a user to use a piece of software and to enter feedback

15   comments as the user is using the software. Our position is that Bolton does

16   not disclose and in fact would teach away from our system where the user's

17   selections of operations would be performed automatically. In Bolton, the

18   entire objective is for the user to have to input feedback data which is

19   directly contrary to our claims where we're just merely monitoring the

20   operations that the user would select.

21   JUDGE MARTIN: I'm sorry, I'm -- we may have to go over that one

22   more time. It seems to me that we're just talking about different kinds of

23   inputs here. On the one hand, in the reference, the user is clicking on the --

24   something in the feedback box, and the Examiner is saying well, the system

25   is, is waiting to see whether -- when and if the Examiner -- the user clicks on

1   that box. That's an input, and so the system is sitting there waiting to see

2   and then it recognizes when the feedback operation is actually being used by

3   the user, right?

4   MR. SACHAR: Yes.

5   JUDGE HOMERE: Yeah, and then on top of that, the Examiner is

6   also saying that as the, the user is clicking on those buttons, the device is

7   automatically recording its incidents.

8   MR. SACHAR: Yeah, as the user clicks on those, it will record what

9   the user is clicking on, but the monitoring operation requires the user to start

10   the monitoring. In our device, the monitoring is started without the user

11   having to provide any inputs.

12   JUDGE HOMERE: No, but how is the user starting any monitoring --

13   MR. SACHAR: The user in Bolton has to enter a feedback command,

14   so the user has to enter a feedback mode.

15   JUDGE HOMERE: Yeah, but -- no, but the user, the user clicking on

16   each of the buttons is equivalent to the user in the claim invention

17   interfacing or interacting with the interface, okay, pressing the buttons

18   because the buttons that are going to be recorded in the log. So really what

19   you have here is that each time the user clicks on the button and then the,

20   the -- there's a record -- there's a log that's recording everything that the user

21   is doing. Okay, but they, they -- the user -- there's nowhere in button that

22   says that what the user hits a button, say well, start monitoring.

23   MR. SACHAR: That's --

24   JUDGE HOMERE: You don't have, you don't have that in Bolton.

25   There's nothing in there that say well, start monitoring. What you have is

1   that the user -- in order to start to enter the feedback mode, the user clicks on

2   the button. Let's suppose he clicks on technical, and then from technical he

3   gets to -- if you look at the, the sequence of, of figures starting on figure 3A.

4   He hits on technical and then, and then from technical he gets down to

5   testing and then enters testing. Okay, all of these entries are being recorded

6   in the log without the user actually say well, start recording. That -- I think

7   that's the distinction that the Examiner was trying to draw here, and I think

8   the appellant, you know, overlooked that.

9   MR. SACHAR: What Bolton states, I'm looking -- I'm quoting at

10   column 4 starting at line 11. "An enter feedback mode command may be

11   activated by the user to provide feedback." If you look at the abstract, a user

12   may activate an enter feedback mode command in a computer environment

13   to provide feedback in a feedback interface.

14   JUDGE HOMERE: Yeah, but the way the user does that is by

15   clicking, is by, is by clicking on one of the buttons on the interface just like

16   in the invention you have the interface and then you have the, the client --

17   the user is pressing buttons and then -- and the user interactions are being

18   recorded.

19   JUDGE MARTIN: I think I see what's going on -- where the problem

20   is here, and my question is that -- the box that's shown in figure 2 on the left,

21   the user learner box, it's -- that thing that the user clicks on, when does that

22   thing -- how does that thing appear to begin with, that box? Does the user

23   bring up that box, or is that box there all the time whenever the, the

24   computer is on?

25   MR. SACHAR: I am not sure of that.

1   JUDGE MARTIN: Isn't that what this -- I mean --

2   MR. SACHAR: That was not the basis for the rejection that --

3   JUDGE MARTIN: No, but I think that's what the Examiner's position

4   is. If that, that box is always there for the user, and it's always being

5   monitored to see whether the user is interacting with it, and when user clicks

6   on something in that box, the computer recognizes that and records the

7   information. And so there's a monitoring going on. Seems to me the whole

8   question is when does -- when is a user presented with the opportunity --

9   first presented with the opportunity to interact using this, this box, this -- is it

10 when the system comes on? Does it come on -- does that opportunity

11 immediately present itself, or does the user have to do something to get into

12 that -- to be able to even get -- provide feedback?

13   MR. SACHAR: My understanding is that the user has to take an

14 action to enter a feedback mode. The user has to indicate a command. I

15 believe that's also the position of the Examiner which is why the Examiner

16 cited a secondary reference to Varga. The Examiner I think has recognized

17 that, that the secondary reference to Varga is cited for the proposition of an

18 automatic monitoring. So I don't think the, the Examiner is -- I do not

19 believe the Examiner is of the opinion that, that Bolton would have that

20 automatic monitoring and that that feedback is automatically entered. That's

21 why it's, it's -- that's why there's a combination of art.

22   JUDGE HOMERE: Well, and I disagree with that, because the

23 Examiner then -- the Examiner spells it out clearly. You turn to page 7 of

24 the Examiner's Answer. The Examiner respectfully disagrees, because this

25 type of activating and enter feedback mode command is totally different than

1   the step of monitoring user's feedback, and it says that the step of recording

2   the feedback record time, the feedback record time at which the feedback is

3   made that's equivalent to, to the monitor, and he says since Bolton teaches

4   recording the feedback at the time at which feedback is made, Bolton

5   inherently teaches, and I'm reading from the Examiner's answer, Bolton

6   inherently teaches monitoring the feedback at the time at which the feedback

7   is made.

8   MR. SACHAR: The, the next sentence says "Although Bolton does

9   not clearly recite the step of automatically monitoring the feedback without

10   user's actions" -- then the Examiner cites again monitoring the feedback at

11   the time it's made. In, in Bolton, the user still has to enter the feedback

12   mode, so the user must say, in other words, my understanding of Bolton is

13   the user doesn't have to give any feedback. So the user can go use this piece

14   of software. There may be no feedback whatsoever. The user has to take an

15   action and enter a feedback mode, and then the user will provide their

16   feedback.

17   JUDGE MARTIN: Okay, let me see -- let me pursue that a second.

18   So by saying that the user has to take an action to enter the feedback mode,

19   you don't -- you're not talking about actually putting in the feedback

20   information. You're just saying to get into a position to be able to input

21   feedback information?

22   MR. SACHAR: Yes.

23   JUDGE MARTIN: Okay, that, that gets back to my question about

24   when that box appears there, and is that what -- by having the user access the

10

1 feedback mode, does that mean bringing up the box in which he can then put

2 in feedback information if he wants to?

3 MR. SACHAR: It's not necessarily clear to me when that box

4 appears. But let me make another point. I think it's largely irrelevant. If the

5 box is always there, it's not monitoring anything until the user enters the

6 feedback mode. The user can go along using this piece of software, clicking

7 on the various parts of this piece of software. Nothing is being monitored

8 even if that box is still there. For the -- for anything to be monitored to

9 provide this feedback, the user will still have to click on that box --

10 JUDGE MARTIN: Yeah, but isn't --

11 MR. SACHAR: -- and then start typing in comments.

12 JUDGE MARTIN: Yeah, but when -- how does the system know that

13 the user has clicked on the feedback box?

14 MR. SACHAR: Well, the user will click on it and then the system --

15 JUDGE MARTIN: Yeah, but the computer recognizes that because

16 it's always looking to see whether there is information coming in, right,

17 where the, where the user has clicked on that display.

18 MR. SACHAR: Yes, the system will detect when the user has clicked

19 on that display.

20 JUDGE MARTIN: Right, and so the system is always -- it's basically

21 monitoring the display to see whether the user clicks on it.

22 JUDGE HOMERE: And, regarding the feedback mode, I mean

23 couldn't -- wouldn't it be reasonable for the Examiner to say that okay, well,

24 by entering the feedback mode, you're starting the feedback mode -- the

25 feedback input application. Okay, so you're getting that started, and by

1   starting that then you start, then you start -- the monitoring starts

2   automatically, right, because --

3   JUDGE BARRY: Okay, there is no, there is no further starting of the

4   monitoring program. When you start the application --

5   JUDGE HOMERE: Exactly, yeah, so --

6   JUDGE BARRY: -- the monitoring starts as part and parcel --

7   JUDGE HOMERE: Because when you enter the feedback mode, it's

8   like you're starting an application, you're starting, you're starting an

9   application just like you're doing in the, in the claim invention. You click --

10   you enter the feedback mode and, and that starts the application.

11   Automatically you start monitoring it.

12   MR. SACHAR: What's being monitored in Bolton is after you enter

13   the feedback mode, all right.

14   JUDGE HOMERE: That's right.

15   MR. SACHAR: So, so after you enter the feedback mode, you can

16   type in comments. That will be monitored.

17   JUDGE HOMERE: That's right, but bear in mind that starting the --

18   entering the feedback mode is starting that feedback mode application.

19   MR. SACHAR: But that is not startup of the device.

20   JUDGE HOMERE: But the device -- remember the devices is not

21   the -- we had a big discussion about that earlier, right, about the device and

22   the, and the application. You said the device is the application, remember?

23   JUDGE MARTIN: Starting the application --

24   JUDGE HOMERE: Yes.

12

1   MR. SACHAR: Right, but starting the, the device. In, in Bolton

2   when you start the device, there is no feedback. There is no automatic

3   monitoring.

4   JUDGE HOMERE: But how come you said that the device is the

5   target application? So the target application as far as the Examiner is

6   concerned, as far as Bolton is concerned, is the feedback mode. So you

7   enter the feedback when you starting that application, and then now you start

8   monitoring.

9   MR. SACHAR: But there, there is no other application being

10   performed at that point. There's no -- it's just, it's just the, the -- it's just

11   typing in comments. It's just the, it's just the, the user's providing their

12   comment.

13   JUDGE HOMERE: Yeah, you -- the user is interacting with the

14   application.

15   MR. SACHAR: What our, what our claim says is selecting -- you

16   monitor the selecting of the plurality of operations of the operation panel by

17   the user.

18   JUDGE HOMERE: That's right.

19   MR. SACHAR: My understanding is, and I think this is the way the

20   Examiner interpreted, is there's pieces of software in, in Bolton, and the user

21   will be using those, and the user can comment on that usage by entering a

22   feedback mode.

23   JUDGE HOMERE: Okay.

1   MR. SACHAR: The operations are not the feedback. It's what you're

2   using in the software, and then you provide your monitoring by entering

3   your feedback comments.

4   JUDGE HOMERE: No, but the operation is anything that the user

5   does with the interface. That's the operation. Anything the, the user clicks

6   on, that's an operation.

7   MR. SACHAR: That's -- I don't think that's the basis for the rejection.

8   JUDGE HOMERE: No, but, but the -- no, but would that be -- I guess

9   the question is would that be a reasonable interpretation of Bolton. That's

10   the question.

11   MR. SACHAR: Well, I don't know if just a user typing in comments

12   unrelated to the operation of the software the user is using would be

13   selecting operations --

14   JUDGE HOMERE: How is that not related, because if they are

15   different -- I mean the user is entering the feedback more than -- the user can

16   select different categories. How is that not related to that particular

17   application --

18   MR. SACHAR: But that's not the software that the user is actually

19   using. The idea in Bolton is that if a user is using a piece of software, the

20   user will be using it in various ways, clicking on buttons that actually

21   operate the software, and at some point the user can provide comments on

22   that software.

23   JUDGE HOMERE: But the, the user has to enter the

24   feedback mode in order to do that?

25   MR. SACHAR: Yes, that's correct.

14

1   JUDGE HOMERE: All right. Okay.

2   MR. SACHAR: So the operations being selected are not the -- are the

3 operations before the user enters the feedback mode in Bolton. That's what

4 he's providing the feedback on, the operations that the user was --

5   JUDGE HOMERE: Well, I thought the invention -- operation in

6 the -- operation in the invention is anything that -- any interaction that the

7 user has with the device is an operation. Any button -- when you started to

8 explain the invention at the -- in the beginning, the way you explained it,

9 you said that anything that the user does, any interaction that the user has

10 with the device being -- it being a fax machine, any button that the user

11 actually depresses will be recorded in the log. So why would it be

12 different -- any different in Bolton that once the user entered the feedback

13 mode, any button, any other category that the user clicks on, gets recorded?

14 Why would that be different? That's --

15   MR. SACHAR: At that point, it is recording what the user does.

16   JUDGE HOMERE: Exactly.

17   MR. SACHAR: But that's after the user starts the monitoring

18 program. Again, the claims cite without the user directly starting the

19 monitoring program. The idea behind our invention is to get a natural feel

20 for how users would naturally use an image forming device. In --

21   JUDGE HOMERE: Is there anywhere in Bolton that says that well,

22 start monitoring that where the user say well, you know, go ahead, start

23 recording.

15

1   MR. SACHAR: Well, Bolton again talks about entering a feedback

2   mode command which starts the monitoring. Again, the claims cite without

3   the user directly starting a monitoring program.

4   JUDGE BARRY: Yes, directly. So what you just described sounds

5   awfully indirect to me. You start the feedback log, and that indirectly starts

6   the monitoring program. But Judge Homere is saying direct to us would be

7   a button that says okay, start monitoring now.

8   JUDGE HOMERE: That's right.

9   MR. SACHAR: And that's exactly what Bolton has. The button that

10   says start monitoring now.

11   JUDGE HOMERE: No, what Bolton has, Bolton has the user

12   entering a feedback mode which is like you starting up a target application.

13   That's what I'm saying. You starting up --

14   MR. SACHAR: But that's, that's --

15   JUDGE HOMERE: -- and by entering the feedback mode, then the,

16   the monitoring starts automatically without someone saying that well, you

17   know, I think that would be grounds for this argument here if upon the user

18   entering the feedback mode, and then the user has to press the button, say

19   well, start recording. But the user didn't do that. The user entered the

20   feedback mode, and automatically every interaction thereafter is recorded.

21   MR. SACHAR: The feedback mode is a monitoring program. Do

22   you agree?

23   JUDGE BARRY: Okay, that's your position.

24   MR. SACHAR: The feedback mode is a monitoring program. That's

25   the only monitoring program in Bolton is entering the feedback mode. Our

1   device and our claims reflect we perform the monitoring without the user

2   having to enter the monitoring program, without the user having to start the

3   monitoring program.

4   JUDGE HOMERE: I think, I think we get your point. Do you have

5   anything else? I think we, we understand your argument.

6   MR. SACHAR: That's all, Your Honors.

7   JUDGE MARTIN: All right, thank you, counsel.

8   MR. SACHAR: Thank you very much for your time.

9   (Whereupon, the hearing concluded on January 22, 2009.)